

Amendment and Response Under 37 C.F.R. §1.116 - Official Expedited Examining Procedure Page 6 of 8
Serial No.:09/701,947
Confirmation No.: 9854
Filed: December 5, 2000
For: STABILIZED BIOACTIVE PEPTIDES AND METHODS OF IDENTIFICATION, SYNTHESIS AND USE

Remarks

The Final Office Action mailed 4 November 2003 has been received and carefully reviewed. Claim 89 having been amended, and claims 1, 61-88, 98-103 and 106-119 having been canceled, the pending claims are claims 89-97, 104, 105 and 120-128.

Claim 89 has been amended to correct a spelling error. Claims 1, 61-88, 98-103 and 106-119 are cancelled as being drawn to a non-elected invention in order to put the application into condition for allowance.

Reconsideration and withdrawal of the rejections in view of the above amendments and the following comments are respectfully requested.

Rejection under 35 U.S.C. §103

The Examiner rejected claims 89, 91, 104, 105 and 120 under 35 U.S.C. §103(a) as being as being unpatentable over Anderson et al. (U.S. Pat. No. 6,562,617) taken with Vanhoof (FASEB J. (1995) 9:736-744). This rejection is respectfully traversed.

The instant application was filed as a U.S. National Stage Application of PCT/US99/23731 (filed October 13, 1999) under 35 U.S.C. §371 on December 5, 2000. Anderson et al. was published May 13, 2003 and claims as its earliest priority date, October 8, 1998. Anderson et al. thus qualifies as prior art under 35 U.S.C. §102(e).

A Declaration Under 37 C.F.R. §1.131 by applicant Elliot Altman is submitted herewith to antedate Anderson et al. The Declaration Under 37 C.F. R. §1.131 establishes completion of the invention by the applicant prior to the effective date of Anderson et al., thereby removing Anderson et al. as a prior art reference.

Pursuant to MPEP 715.02, it is submitted that Applicant's showing of possession of the invention prior to the effective filing date of Anderson et al., one of a plurality of combined references, obviates the rejection of claims 89, 91, 104, 105 and 120 as being obvious over Anderson et al. taken with Vanhoof. Reconsideration and withdrawal of the rejection of claims

Amendment and Response Under 37 C.F.R. §1.116 - Official Expedited Examining Procedure Page 7 of 8

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89, 91, 104, 105 and 120 under 35 U.S.C. §103(a) as being unpatentable over Anderson et al. taken with Vanhoof, is accordingly respectfully requested.

The Examiner rejected claims 89, 90, 104, 105 and 121-128 under 35 U.S.C. §103(a) as being unpatentable over Anderson et al. (U.S. Pat. No. 6,562,617) taken with Plaxo et al. (Curr. Opin. Stru. Biol. (1998) 8:80-85), Wood (US. Pat. No. 6,630,197), Ni et al. (U.S. Pat. No. 6,566,498) and Sachdev et al. (Prot. Exp. Purif (1998) 12:122-132). This rejection is respectfully traversed.

As described above, the cited document Anderson et al. is antedated by the accompanying Declaration Under 37 C.F.R. §1.131. Therefore, pursuant to MPEP 715.02, Applicant respectfully requests that the rejection of claims 89, 90, 104, 105 and 121-128 under 35 U.S.C. §103(a) as unpatentable over Anderson et al. taken with Plaxo et al., Wood, Ni et al. and Sachdev et al. be reconsidered and withdrawn.

Ambiguous Status of Claims 92-97

Applicant notes that although the Office Action Summary sheet indicates claims 92-97 were rejected, the rejections under 35 U.S.C. §103(a) set forth at pages 2 and 4 in the Office Action do not list claims 92-97 as being rejected. Further, the Office Action states at page 2 that grounds of objection and/or rejection not explicitly restated and/or set forth below are withdrawn. The Examiner's arguments in the Office Action do cite Plaxco et al. and Wood et al. as teaching certain elements of these claims, but claims 92-97 are not explicitly rejected in the Office Action. There is accordingly an inconsistency between the Office Action Summary and the Office Action itself regarding the allowability of claims 92-97.

Applicant submits that claims 92-97, as well as the other pending claims (claims 89-91, 104, 105 and 120-128) are in condition for allowance. However, if the Examiner determines that the claims are not allowable, Applicant requests clarification of the status of claims 92-97 and the removal of the finality of the Office Action mailed 4 November 2003 in order to be accorded a full and fair opportunity to address the Examiner's arguments.

Amendment and Response Under 37 C.F.R. §1.116 - Official Expedited Examining Procedure Page 8 of 8

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It is respectfully submitted that pending claims 89-97, 104, 105 and 120-128 are in condition for allowance, and notification to that effect is earnestly requested.

If the claims are not deemed to be in condition for allowance, Applicant requests that the finality of the Office Action be removed, for reasons described above.

The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted or expedited in any way thereby.

Respectfully submitted for
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FOUNDATION

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this

4 day of MARCH 2004, at 3:50 pm (Central Time).

By:

Name:

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